

REMARKS

Claim 128 is currently amended. Claims 1-127, 131 and 140 have been previously canceled. Claims 134-136 and 143-145 have been previously withdrawn. Claims 128-130, 132-133, 137-139 and 141-142 are currently under examination. Reconsideration of the application in view of the current claims is respectfully requested and further in view of the following Remarks.

I. CLAIM REJECTIONS UNDER 35 U.S.C. § 101

The Examiner has rejected claims 128-130 and 132-33 under 35 U.S.C. §101 as drawn to non-statutory subject matter (Office Action, page 4). The Examiner asserts that:

The method claims of the instant application (instant claims 128-130 and 132-133) recite a series of steps without physical transformation. Further, the claims fail to recite a tie to another statutory class of invention. It is noted that while the result of the calculation is identified on a user interface, this final step is an insignificant post-solution activity and does not constitute a significant tie to another category of invention.

Applicants respectfully request reconsideration.

Applicants have amended claim 128 to indicate that each step is executed by computer code. In In re Bilski (Fed.Cir. 2007-1130), the Federal Circuit articulated the “apparatus or transformation” test for process claims (page 10). According to this test, a process is patentable if it is tied to a specific machine or apparatus. As amended, the steps of claim 128 are tied to an apparatus because they are performed on a computer by executing code that performs a number of tasks including searching a medical literature database. Accordingly, they comply with the legal standard for eligible subject matter under 35 U.S.C. § 101.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(A)

The Examiner has rejected claims 128-130, 132-133, 137-139, and 141-142 under 35 U.S.C. § 103(a) as being unpatentable over DiGregorio et al., (Obesity Surgery, volume 11, 2001, pages 318-326, hereinafter “DiGregorio”) in view of Siffert et al. (Journal of the American

Society of Nephrology, volume 10, 1999, pages 1981-1930, hereinafter "Siffert") in view of Rappaport (US PG PUB 2002/07285 A1, hereinafter "Rappaport"). The Examiner asserts that DiGregorio shows translating a medical condition, obesity, into an identifier of a medical literature database system. He continues that the search of the Cochrane database described there represents the use of an evidence-based medicine filter. The Examiner cites Siffert for the idea that obesity includes a genetic component, and, therefore, it would be obvious to test to this gene and then to translate this profile into the medical identifier. He uses Rappaport (which we have discussed previously) to support the idea of automation.

To establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. Mere identification in the prior art of each element is insufficient to defeat patentability of the combined subject matter. There must also be some suggestion or motivation to modify the reference or to combine reference teachings. *See* MPEP § 2142. Thus, there must be some positive, concrete evidence which gives a logical reasoning which justifies a combination of references. Further, Applicant's explanation of how the invention works does not render obvious that which is otherwise unobvious. Finally, there must be a reasonable expectation of success and the references must teach or suggest all of the claim limitations.

In practice, this requires that the Examiner explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. Further, the factual inquiry of whether to combine references must be based on the objective evidence of record. Failure to meet that burden is a basis for the Board to overturn the obviousness rejection. The Examiner cannot simply use Applicant's teaching to show that a person of ordinary skill would have been led to the combination of references. Similarly, the Examiner cannot provide conclusory statements supporting the rejection. As the Federal Circuit has noted the motivation-suggestion-teaching requirement protects against the entry of hindsight into the obviousness analysis.

Applicants respectfully traverse.

First, DiGregorio did not show executing computer code that receives a genetic profile from a patient. Nor is this element obvious in view of Siffert. Siffert states that the 825T allele “may contribute to obesity.” (Siffert, Abstract.) Therefore, the fact that a person carries the allele does not mean that person is obese or will be obese. Obesity surgery is considered for persons who are obese, not for persons who carry a gene for predisposition to obesity. Accordingly, in the context of DiGregorio’s interest in performing a search on obesity surgery, the references provide no motivation to a practitioner to first perform a genetic test on the patient to determine that the patient carried a gene predisposing the person to obesity.

Second, DiGregorio did not show executing computer code that translates a genetic profile into one or more identifiers of a medical literature classification system for a medical literature database. “Obesity” is not a genetic profile. Siffert does not show a gene that indicates a person is obese. Nor is “obesity” a condition translated into an identifier of a medical literature classification system by DiGregorio. DiGregorio searched a database for the terms used in Table 2 of the reference. None of these terms is an identifier of a medical literature classification system. Nor was there prior translation of any genetic profile into any of these terms by computer, as the claim requires.

Third, and very significantly, DiGregorio did not show searching the medical literature database for medical literature articles relating to the one or more identifiers using computer code that executes an evidence based medicine filter. DiGregorio searched the Cochrane Library. This database is already filtered for evidence-based medicine. (DiGregorio, page 323, column 2, second paragraph in “Discussion”.) Accordingly, a computer search of that database does not involve the separate step of using an evidence-based medicine filter to search it. Rather, only the search terms described in Table 2 of DiGregorio were used to search this database – DiGregorio does not describe also searching it using an evidence based medicine filter.

In sum, the combination of Siffert and DiGregorio does not provide motivation to receive a genetic profile from a patient, as there is no evidence that the presence of the 825T allele plays a role in making a decision about performing obesity surgery. Second, and very importantly, no reference cited shows the use of an evidence based medicine filter to search a database along with

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an identifier of a medical literature classification system. The combination of Rappaport for automation does not supply the missing elements.

For these reasons, the references cited do not render the invention obvious. Applicant requests the Examiner to withdraw the rejection.

CONCLUSION

For the foregoing reasons, Applicants request the Examiner allow claims 128-130, 132-133, 137-139, and 141-142 and advance the application to issuance.

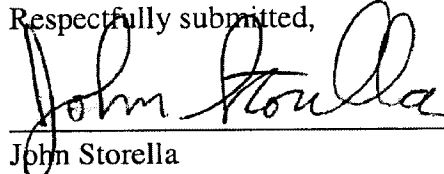
FEE AUTHORIZATION

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account No. **23-2415** (Docket No. 29954-701.201).

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By:

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